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John P. M.

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 08/894,824 | 08/29/97 | FRIEBE | R BAYER9930-WC |

IM12/0714
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| EXAMINER | |
|----------|--------------|
| GLASS, M | |
| ART UNIT | PAPER NUMBER |

1712

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DATE MAILED: 07/14/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/894,824

Applicant(s)

Friebe et al.

Examiner

Margaret Glass

Group Art Unit

1712



☒ Responsive to communication(s) filed on Apr 20, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1 to 6 and 8 to 13 is/are pending in the application.

Of the above, claim(s) 11 and 12 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1 to 6, 8 to 10 and 13 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 to 6, 8 to 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wakabayashi et al. in view of Kimura et al. for reasons of record.

Applicants argue that the problems encountered with polysiloxanes differ from those of organic polymers and that the problem of stability for Si-O-Si bonds does not exist in the case of polyethers. This is not persuasive both references are drawn to RTV compositions and Kimura et al. specifically indicate that either polyethers or polysiloxanes can be used, providing one with a reasonable expectation of success in using polyethers for polysiloxanes in an equivalent manner. Applicants have not shown any unexpected results, with regards to stability or anything else, that would negate this expected equivalence. Applicants provide no support for their assertion that those skilled in the art would understand that these polymers are not equivalent, especially in view of the contradictory teachings of Kimura et al. The compositions do not appear to be totally different as argued since they are both moisture curing RTV compositions having the same utility. As such this rejection is maintained.

3. Claims 1 to 6, 8 to 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schiller et al. in view of Sattlegger et al. for reasons of record.

Applicants argue that the present application improves storage stability whereas Schiller et al. is concerned with rheology. Note, however, that a prima facie case of obviousness (for a composition) does not require the solution of the same problem or recognition of the same advantages as the applicants invention. *In re Dillon* 16 USPQ2d 1897 (CAFC, en banc, 1990),

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which overrules *In re Dillon* 13 USPQ 2d 1337 and *In re Wright* 6 USPQ 2d 1959. As such this argument is not persuasive.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication should be directed to Margaret Glass at telephone number (703) 308-4334.

Any **official** documents (after final rejection) can be faxed to (703) 305-3599. All other **official** faxes should be sent to (703) 305-5408. Please do not send any informal communication or proposed amendments to this number.


Margaret Glass
Primary Examiner
Art Unit 1712

mwg
July 13, 1998